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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,199	04/13/2004	Akio Saiki	5000-5167	4036
27123 7590 02/06/2009 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
PARVINI, PEGAH				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
02/06/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com  
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### Office Action Summary

**Application No.**

10/823,199

**Applicant(s)**

SAIKI ET AL.

**Examiner**

PEGAH PARVINI

**Art Unit**

1793

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1 and 20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 1 and 20** recite the limitation of having 15% to **100%** by mass of polytetrafluoroethylene based on 100% by mass of the binder resin (i.e. polyimide or polyamide-imide); it is unclear as how there could be any binder resin or any of the other components if there is 100% by mass of polytetrafluoroethylene.

**Claim 20** recites the limitation of "obtainable" in "wherein the film is obtainable by mixing the coating composition..."; the term "obtainable" is found indefinite as it is not clear whether the film is made by the process steps which follows this segment of the claim language or not.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-4, 7 and 15-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,742,110 to Sakashita et al. in view of US Patent No. 5,948,339 to McDermott et al.

Regarding claims 1, 3-4, 7, and 15-20, Sakashita et al. disclose a polyamide moldable composition which has improved mechanical and thermal characteristics wherein said composition comprises polyamide-imide, a mixture of one or more fillers such as titanium oxide powder and polytetrafluoroethylene (i.e. PTFE) each in an amount of, preferably 0.5 to 50 parts by weight per 100 parts by weight of the polyamide and silane coupling agent which is used to treat the fillers (Abstract, column 1, line 60 to column 2, line 5; column 5, line 62 to column 6, line 47).

The reference although disclosing the treatment of fillers with silanes, does not expressly disclose the amount of said silane used.

However, the amount of silane to be use to treat the filler(s) would have been obvious to one skilled in the art based on routine experimentation to optimize the amount of the silane in order to optimize the cross linking of the components as also motivated by McDermott et al., drawn to a liquid injection molding composition comprising 0.1 to 10 parts by weight of a silane which is also used to treat the fillers utilized in said composition (column 2, lines 20-29 and 41-45; column 3, lines 33-40; column 7, lines 5-11; column 8, lines 50-55 and 65-68; column 9, lines 12-16), which shows a conventional amount of silane used to treat filler. It is to be noted that titanium oxide is disclosed as a filler utilized in McDermott et al.

It is noted that there is overlapping ranges of the amount of the titanium oxide powder and PTFE with the ones instantly claimed, and overlapping ranges have been held to establish *prima facie* obviousness. MPEP § 2144.05.

With reference to the preamble reciting "A wear resistance and seizure resistance film formed on a sliding part", it is noted that this is an intended use for the coating composition which follows this segment of the claim language. With reference to the statement of intended use, MPEP § 2111.02 states:

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

With reference to a film forming from said composition, it is noted that Sakashita et al. is drawn to a moldable composition with improved mechanical and thermal characteristics and to a composition which is excellent in molding characteristics. Therefore, it is the position of the examiner that the composition of Sakashita et al. may be molded in any form and shape such as into a film absence clear evidence showing the contrary.

With reference to the recitation drawn to the sliding parts being metal, it is noted that claim 1 is drawn to a coating composition forming film; thus, a recitation drawn to metal sliding parts as claimed in claim 19 does not impart any limitation on the composition of claim 1.

**Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakashita et al. in view of McDemott et al. as applied to claim 1 above, and further in view of US Patent Application Publication No. 20020161091 to Amou et al.

Regarding claim 2, the combination of Sakashita et al. in view of McDemott et al. disclose a resin (i.e. polyamide) composition comprising titanium oxide powder, PTFE, polyamide-imide and silane in amount which would have overlapping ranges with the amounts instantly claimed.

The references although disclosing the use of titanium oxide powder, do not expressly disclose the particle size of this powder. However, the size of titanium oxide powder would have been obvious to one of ordinary skill in the art motivated by the fact that Amou et al., drawn to resin composition used as a molding material which can be easily poured into a mold a complicated shape also in the form of film ([0053]) and comprises a cross linking component and a filler, disclose the use of titanium oxide as a filler in said resin composition wherein said titanium oxide particle has an average diameter of 0.1-100 microns ([0024]); further, this combination and the use of titanium oxide particles having a particle size which has overlapping ranges with the ones instantly claimed would have been obvious to one of ordinary skill in the art motivated by the fact that the particle diameter of the filler affects the thickness of a layer ultimately formed as well as other characteristics of the layer ([0060]). Additionally, it is noted that said resin composition of Amou et al. which is used in the form of a curable film comprises polymers made of monomers such as acrylonitrile which is known to

form polymeric binder resin; thus, the composition of said reference also comprises a binder resin.

***Response to Amendment***

Applicants' amendment to claims 1, 4, 15 and 20, filed November 17, 2008, is acknowledged. However, said amendments do not place the application in condition for allowance.

***Response to Arguments***

Applicants' arguments with respect to claims 1-4, 7 and 15-20 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegah Parvini/  
Examiner, Art Unit 1793

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793